REMARKS

Applicants appreciate the Examiner's thorough examination of the present application as evidenced by the Office Action of October 24, 2005 (hereinafter "Office Action"). Applicants especially appreciate the indication that Claims 8, 9, 33, 34, 55, and 56 recite patentable subject matter. Rather than writing various ones of the foregoing claims in independent form at this time, Applicants respectfully submit that the cited references are not properly combinable and, even if combined, do not disclose or suggest all of the recitations of the independent claims. Accordingly, Applicants submit that all pending claims are in condition for allowance. Favorable reconsideration of all pending claims is respectfully requested for at least the reasons discussed hereafter.

Independent Claims 1, 10, 23, 26, 35, 48, and 57 are Patentable

Independent Claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the document entitled "Webhire Links Corporate Recruiting Desktops to Over 2,000 Job Posting Sites," March 2, 2000 (hereinafter "Webhire") in view of the document entitled "Find what I mean, not what I say," May/June 2000, by Feldman (hereinafter "Feldman").

Independent Claim 1 is directed to a method of selecting a job post site and has been reproduced below:

> obtaining at least one job post site selection criterion;
> automatically ranking a plurality of job post sites based on the at least one job post site selection criterion, comprising:
> accessing a fact table that contains data relevant to the at least one job post site selection criterion; and
> using an inference engine to process the at least one job post site selection criterion and the fact table to rank the plurality of job post sites based on the at least one job post site selection criterion; and
> selecting the job post site from the plurality of job post sites based on the ranking of the plurality of job post sites.

Claims 10, 23, 26, 35, 48, and 57 include similar recitations. Thus, according to the recitations of the pending independent claims, a plurality of job post sites are automatically ranked based on at least one job post site selection criterion by accessing a fact table that contains data relevant to the at least one job post site selection criterion and by using an inference engine to process the at least one job post

site selection criterion and the fact table to rank the plurality of job post sites based on the at least one job post site selection criterion.

The Office Action acknowledges that Webhire does not teach or suggest the recitations directed to automatically ranking a plurality of job post sites, accessing a fact table, and using an inference engine. (Office Action, page 4). The Office Action does allege, however, that Feldman provides the missing teachings. Applicants respectfully submit, however, that neither Webhire nor Feldman include any motivation or suggestion to modify Webhire as indicated in the Office Action. Moreover, even if Webhire were to be modified with the teachings of Feldman, Applicants submit that the combination does not disclose or suggest all of the recitations of the independent claims.

A determination under §103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 107 S.Ct. 2187. After the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was unknown, and just before it was made. *Id.* at 1596. The United States Patent and Trademark Office (USPTO) has the initial burden under §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a prima facie case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. §2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In another decision, the Court of

Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be **particular** evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

As affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. *See In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." Feldman discusses the desirability of using natural language processing (NLP) technology to improve the effectiveness of Internet search engines. (*See, e.g.*, paragraph 6). That is, Feldman explains that an Internet search engine may perform a better search if the search word or phrase is interpreted using NLP technology to arrive at a better meaning for the search word or phrase. This may reduce the frequency with which an Internet search engine returns results that are irrelevant or off topic from what the searcher had intended to search for.

Webhire describes the use of a search tool to provide corporate recruiters with assistance in identifying job sites that are best suited for posting their particular job openings. (Webhire, paragraph 2). Webhire explains the operation of the search tool as follows: "Corporate recruiters indicate the type of position they are filling, for example, engineering or accounting, and quickly receive an online listing of the specific job sites within the service that are most likely to attract qualified candidates for those specific openings." (Webhire, paragraph 6). Applicants submit that there would be no motivation to incorporate NLP technology into Webhire's search tool because the search tool is limited in scope to job types. A user would be unlikely to type ambiguous queries into Webhire's job post search tool that would need to be interpreted to figure out what type of position, e.g., engineering or accounting, the user is trying to fill. Applicants submit that there would be no motivation to modify Webhire's search tool with NLP technology as such a modification would merely increase the expense of Webhire's system without providing any additional benefit. Thus, it appears that the Office Action gains its alleged impetus or suggestion to combine the cited

references by hindsight reasoning informed by Applicants' disclosure, which, as noted above, is an inappropriate basis for combining references.

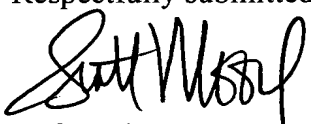
For the sake of argument, even if the teachings of Webhire and Feldman were combined, their combination would not disclose or suggest all of the recitations of independent Claim 1. As discussed above, Feldman suggests the desirability of using NLP technology to improve searches on Internet search engines. Thus, if Webhire's search tool were to be modified with NLP technology, then even if a corporate recruiter is imprecise in identifying what type of position he/she is trying to fill when using the search tool, the NLP technology may be able to interpret the meaning of the recruiter's query and return a listing of specific job sites where a job posting for the position may attract qualified candidates. The combination of Webhire and Feldman does not address at all how Webhire selects the various job post sites based on the search query/term and does not suggest automatically ranking the selected job post sites. Accordingly, The combination of Webhire and Feldman does not disclose or suggest accessing a fact table that contains data relevant to at least one job post site selection criterion and using an inference engine to process the at least one job post site selection criterion and the fact table to rank the plurality of job post sites based on the at least one job post site selection criterion as recited in independent Claim 1.

Accordingly, for at least the foregoing reasons, Applicants respectfully submit that independent Claims 1, 10, 23, 26, 35, 48, and 57 are patentable over the cited references and that Claims 3 - 9, 11 - 14, 16 - 22, 25, 28 - 34, 36 - 39, 41 - 47, 50 - 56, 58 - 61, 63 - 69 are patentable at least per the patentability of independent Claims 1, 10, 23, 26, 35, 48, and 57.

CONCLUSION

In light of the above amendments and remarks, Applicants respectfully submit that the above-entitled application is now in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

Respectfully submitted,



D. Scott Moore
Registration No. 42,011

USPTO Customer No. 20792
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401

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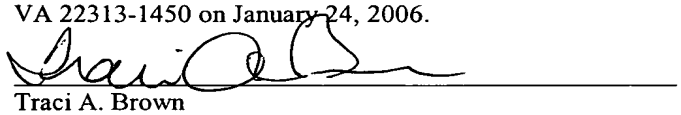

Traci A. Brown